

Appl. No. 09/656,258
Amendment Dated August 6, 2003
Reply to Office Action of May 6, 2003

REMARKS/ARGUMENTS

Responsive to the Office Action Applicants have filed herewith a Request for Continued Examination of Claims 1, 2, 8 through 26, and 29 through 31. Claims 1, 17, 29 and 30 have been amended currently and new Claim 31 is presented herewith. Consideration for allowance of the claims now pending in this application is requested for the reasons set forth hereinbelow.

In the Office Action, the Examiner rejected Claims 1, 15 and 30 under 35 U.S.C. 102(b) as being anticipated by the disclosure of U.S. Patent 4,160,685 to Kuroda. The Kuroda reference discloses an appliqu  and method of making wherein a base layer of sheet material is provided and a filler layer of resiliently compressible padding material, such as open or closed cell plastic foam, overlays the base layer. The cover layer of sheet material is disposed over the foam layer. An image may be embossed, painted or otherwise applied to the cover layer. The appliqu  of Kuroda is formed by providing a die which engages the layered material described above, includes cutting edges to sever the layers along an outer contour line of the appliqu  and compresses the foam plastic layer to form a three dimensional appliqu  and to provide a cushion between the outer layer or image sheet and the base layer of the structure of Kuroda.

Kuroda does not disclose or suggest a method of making an article such as a portfolio, desk folder, binder, wallet or the like having a cover part which is to be debossed to form a substantially planar indentation with or without the step of simultaneously bonding an image sheet to the underlying member or to recess the image sheet in the member. Thus, the appliqu  of Kuroda is subject to abrasion and wear and tear acting on the outer layer or image sheet which, when used with an article of the type set forth in the claims in this application, would result in a short lived image on such article.

The present invention overcomes problems associated with an appliqu  formed in accordance with the teaching and

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disclosure of Kuroda et al. The method set forth in Claim 1, as currently amended, requires the provision of a cover part for a portfolio, desk folder and the like formed of a flexible and indentable material, debossing that member to form a planar indentation therein while bonding an image sheet to the member in the indentation, the planar indentation having a depth at least as great as the thickness of the image sheet so as to recess the image sheet in the member. In this way, an image placed on an article such as a portfolio, desk folder, binder, wallet, luggage tag, memo pad or key fob, according to Claim 1 has a longer and more aesthetically pleasing life for the user than a three dimensional appliqu  of the type disclosed in Kuroda. Accordingly, reconsideration for allowance of Claim 1, as amended herein, is respectfully requested.

Claim 15 remains in the application depending indirectly from Claim 1 and the overall combination of steps and elements as set forth in Claims 1, 2, 13, 14 and 15 is also believed to distinguish over Kuroda for the reasons set forth above.

In the Office Action, the Examiner rejected Claims 2, 8 through 10 and 13 under 35 U.S.C. 103(a) as being unpatentable over the teaching of Kuroda in view of U.S. Patent 5,380,044 to Aitkens et al. With regard to Aitkens et al., this patent describes a method of printing desired information in reverse on a transparent vinyl sheet which is then fused to a plastic substrate to seal the printed ink on the sheet between the vinyl sheet and the plastic substrate and to allow the ink to reach into and permanently mark the substrate. Applicants respectfully submit that the process of making identification cards as suggested by Aitkens et al., when combined with the teaching of Kuroda, would not suggest the overall combination of steps set forth in Claims 1 and 2, or Claims 1, 2 and 8, or Claims 1, 2, 8 and 9, or the combination of Claims 1 and 10 or the combination of Claims 1, 2 and 13. The steps set forth in Claims 2, 8 and 9 and the steps set forth in Claims 10 and 13 taken together with the steps of Claim 1 are clearly not made

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obvious to one or ordinary skill in the art taking into consideration Kuroda and Aitkens et al. Modifying an appliqué, such as taught by Kuroda, in accordance with the teaching of the manufacture of identification cards does not suggest the provision of an article such as a portfolio or desk folder, having an image sheet formed thereon in such a way as to protect the image sheet by providing the image sheet in a planar indentation which is at least as great as the thickness of the image sheet whereby the image sheet is recessed in the member and wherein the image sheet is provided from a larger sheet of the same material, as set forth in Claim 2, or wherein an image is printed on the image sheet as part of a larger sheet and comprising opaque precolored material, as required by Claim 8 or wherein the image source is obtained by scanning and copying the image and transferring the image to a printing apparatus for printing the image on the image sheet, as required by Claim 9, or by applying an ink receptive coating on the image sheet prior to printing the image thereon as provided by Claim 10. Still further, the overall combination of steps of Claims 1, 2 and 13 are not believed to be made obvious by the combined teaching of Kuroda and Aitkens et al., particularly taking into consideration the requirements of amended Claim 1. Reconsideration for allowance of Claims 2, 8 through 10 and 13 is requested.

Reconsideration for allowance of Claim 11 is requested. The overall combination of steps of providing an image sheet which is recessed in a planar indentation on a cover part as required by Claim 1, together with providing a textured surface on the image sheet prior to applying a coating to the image sheet is not believed to be obvious in view of the teaching of Kuroda in view of Aitkens et al. and further in view of U.S. Patent 5,891,552 to Lu et al. The textured surface on the image sheet as required by Claim 11 and where the image sheet is disposed in a recess or indentation having a thickness at least as great as the thickness of the image sheet is an important

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consideration in a high wear rate article of the type set forth in Claim 1. Neither Lu et al, nor Aitkens et al. or Kuroda suggest, taken alone or one modified in view of the other, providing the overall combination of steps and features of Claim 11 and reconsideration for allowance is requested.

Reconsideration for allowance of Claims 12, 14 and 16 is requested. These claims have been rejected under 35 U.S.C. 103(a) as being unpatentable over the teaching of Kuroda in view of Aitkens et al. and further in view of Jenkins (U.S. 5,974,230). As mentioned previously, Applicants verily believe that one skilled in the art of methods for manufacturing articles comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or key fob would not look to the art of making labels for attachment to file folders to provide the overall combinations of steps of Claims 1 and 12, or Claims 1, 2, 13 and 14 or Claims 1, 2 and 13 through 16, directed to a method of making an article of the type described above to provide a printed image thereon. Reconsideration for allowance of Claims 12, 14 and 16 is respectfully requested.

Reconsideration for allowance of Claims 17, 19, 20, and 24 through 26 is requested. These claims were rejected under 35 U.S.C. 103(a) as being obvious in view of the teaching of Kuroda in view Aitkens et al. Claim 17 has been amended somewhat along the lines of the amendments to Claim 1 by reciting that an image sheet is bonded to a member of flexible and indentable material forming at least a cover part of an article such as a portfolio, desk folder and the like by engaging an image sheet with a debossing die and applying RF energy to bond the image sheet to the member at a planar indentation formed in the member whereby the image sheet is disposed in a debossed window formed in the member having a depth at least about equal to the thickness of the image sheet. In at least these respects Claim 17 is believed to clearly distinguish over the teaching of Kuroda in view of Aitkens et al. As pointed out above, Kuroda discloses a method for forming an appliqu  having substantial three

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dimensional aspects which would not be suitable for an image sheet applied to an article of the type set forth in Claim 17. With regard to the teaching of Aitkens et al., this patent describes a method of printing desired information in reverse on a transparent vinyl sheet which is then fused to a plastic substrate such as an identification card. Clearly, there is no suggestion in Aitkens et al., nor in Kuroda, nor one reference modified in view of the other, to provide a planar indentation in a cover member of an article such as a portfolio or desk folder or the like and providing an image sheet disposed in a debossed window formed in the member having a depth at least about equal to the thickness of the image sheet to minimize abrasion or lifting of the edge of the image sheet. Consideration for allowance of Claim 17, as amended, is requested.

Reconsideration for allowance of Claims 19, 20 and 24 through 26 is requested at least for the reasons set forth above in support of the patentability of Claim 17. With regard to Claim 20, in particular, the references do not suggest locating a guide device on the member for guiding placement of the image sheet and placing the image sheet on the member in a predetermined position as provided by the guide device in combination with the other steps of the claim.

Further reconsideration for allowance of Claims 18 and 20 is requested. These claims were rejected under 35 U.S.C. 103(a) over Kuroda in view of Aitkens et al. and further in view of Kaule (U.S. 5,817,205). Kaule again is from a somewhat diverse art unrelated to the manufacture of articles such as portfolios or desk folders. Kaule suggests providing smooth and finished surfaces on a document for application of a bonding agent thereto followed by transfer of an endless hologram to a glazed stripe or stripes formed on the document surface. So-called positioning means is described but not shown. Claim 18 recites the step of debossing the flexible and indentable member to form the indentation to provide a guide for locating the image sheet

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prior to placing the image sheet in contact with the member and recessed as required by Claim 17. Claim 20 requires the location of a guide device for guiding placement of the image sheet at a predetermined position on the member. Again, modification of Kuroda as suggested by Aitkens et al. and Kaule, all in unrelated arts with respect to the present invention, is not believed to make obvious the combined steps of Claims 17 and 18 or 17 and 20.

Reconsideration for allowance of Claim 21 is requested. This claim was rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Aitkens et al. and further in view of U.S. Patent 2,602,560 to Pargh. The Pargh reference discloses a labeling machine which provides spots or focus points on the surface of an article to indicate a point at which a label is to be placed. The combination of steps in Claims 17 and 21 is not believed to be made obvious by the combined teaching of the Kuroda, Aitkens et al. and Pargh references. The references are all from diverse arts, not related to a method of making an article with a printed image thereon, such as a desk folder or binder, and there is no suggestion to provide the overall combination of steps in Claims 17 and 21.

Reconsideration for allowance of Claims 22 and 23 is requested. These claims have been rejected over Kuroda in view of Aitkens et al. and further in view of Jenkins under 35 U.S.C. 103(a). As pointed out hereinabove, the combined teaching of these references from diverse arts is not believed to be obvious to one of ordinary skill in the art of making articles such as portfolios and desk folders with printed images thereon, particularly taking into consideration the requirements of Claim 17.

In the Office Action, the Examiner rejected Claim 29 under 35 U.S.C. 103(a) over Kuroda in view of Kaule. Claim 29 has been amended to recite that the cover part of a portfolio or desk folder and the like is debossed to form a substantially planar indentation about equal to the thickness of an image

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sheet together with the steps of placing an image sheet in contact with the member within the indentation and bonding the image sheet to the member within the indentation. As pointed out hereinabove, the teaching of Kuroda would not provide for a method as required by Claim 29 and would not satisfy the requirements for recessing an image sheet within a debossed area on a member forming a cover part of a portfolio or desk folder, as required by the claim.

Claim 30 has been amended along the lines of the amendments to Claims 1 and 17 and is believed to be patentable at least for the reasons set forth above in support of the patentability of Claims 1 and 17, respectively.

Applicants present with this amendment new Claim 31 based somewhat on Claim 17 but including recitation of the steps of placing an image sheet in contact with a substantially planar surface of a member forming a cover part of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or key fob and bonding the image sheet to the member by engaging the image sheet with a substantially planar die, applying RF energy to bond the image sheet to the member whereby a substantially planar image is presented on the member. In at least these respects Claim 31 is believed to be patentably distinct. None of the references of record in this application pertain to a method of making an article of the type set forth in Claim 31 and including the steps of providing an image sheet as required by the claim, nor including the steps of bonding an image sheet to a cover part of an article of the type set forth in Claim 31 to provide a substantially planar image.

Applicants verily believe that the methods set forth in the claims presented with this amendment are novel and patentable in the art of making articles of the type required by the claims. Such articles should be durable and the images formed thereon should be long lasting for various reasons so that the articles are presentable even though subject to wear and tear in normal use. The diverse arts which the references

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of record address would not be explored by one skilled in the art of articles of the type set forth in the claims in this application and, accordingly, Applicants verily believe that it would not be obvious to one skilled in the art of articles, such as portfolios, desk folders, binders, wallets, luggage tags, memo pads or key fobs to provide images on such articles in accordance with the methods set forth in the claims and consideration for allowance of the claims now pending in this application is respectfully solicited.

Respectfully submitted,

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Michael E. Martin

Michael E. Martin
Registration No. 24,821
Agent for Applicants

Gardere Wynne Sewell LLP
1601 Elm Street, Suite 3000
Dallas, Texas 75201-4761
Phone (214) 999-4052
Fax (214) 999-3052

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